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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,430	03/31/2004	Gregory M. Plow	SVL920030143US1	7637
55070 7590 07/01/2008 INTERNATIONAL BUSINESS MACHINES CORP. (JMS) IP LAW 555 BAILEY AVENUE, J46/G4 SAN JOSE, CA 95141			EXAMINER AUGUSTINE, NICHOLAS	
			ART UNIT 2179	PAPER NUMBER
			NOTIFICATION DATE 07/01/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/815,430	Applicant(s) PLOW ET AL.	
	Examiner NICHOLAS AUGUSTINE	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13,40,41 and 46-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,40,41 and 46-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/26/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- A. This action is in response to the following communications: Request for Continued Examination filed 03/26/2008
- B. Claims 1-13, 40-41 and 46-56 remains pending.
- C. Claims 14-39 and 42-45 are cancelled. Claims 46-56 are new.
-

Continued Examination Under 37 CFR 1.114

D A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/26/2008 has been entered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the

United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-13, 40-41 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Graham, Jamey (US 7,228,492 B1), herein referred to as "Graham".

As for Claims 1, Graham teaches a method and corresponding article and apparatus of displaying information, comprising: presenting a first subset of information in a scrollable area (figure 5, 502), the first subset of information comprising, at least in part, a second subset of information (530b and 506), the second subset of information being designated as a materialization entity (506), wherein the materialization entity is not displayed in a materialization area (col.8, lines 24-26; the user is able to take away the materialization entity by having an option of choosing what content to pull from a particular document), thus not being displayed; and in response to the first subset of information in the scrollable area being scrolled and at least a portion of the materialization entity scrolled out of the scrollable area, displaying the materialization entity, at least in part, in a materialization area (col. 6, lines 33-67 and col.7, lines 1-23; wherein a user is displayed with digital content which is scrollable, the content is dynamically materialized into pieces as the user views the information; hence when the user scrolls through the documents the system dynamically materializes information based on user preferences and displays it in an adjacent window/frame/pane).

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As for Claims 2, Graham teaches the method and corresponding article and apparatus further comprising: associating a materialization attribute with the materialization entity to designate the second subset of information as the materialization entity (col.6, lines 40-44).

As for Claims 3, Graham teaches the method and corresponding article and apparatus wherein the scrollable area is in a window and the materialization area is also in that same window (figure 4).

As for Claims 4, Graham teaches the method and corresponding article and apparatus wherein the scrollable area is in a first window, and wherein the materialization area is in a second window, different from the first window, to provide a materialization window (figure 5).

As for Claims 5, Graham teaches the method and corresponding article and apparatus wherein the materialization window is adjacent to the first window (figure 5).

As for Claims 6, Graham teaches the method and corresponding article and apparatus further comprising: in response to the at least a portion of the materialization entity scrolled out of the scrollable area, displaying the materialization area (figure 5).

As for Claims 7, Graham teaches the method and corresponding article and apparatus further comprising: displaying the materialization area in response to a user activation (figure 6a).

As for Claims 9, Graham teaches the method and corresponding article and apparatus wherein a third subset of the information of the first subset of information is designated as an additional materialization entity; and in response to at least a portion of the additional materialization entity being scrolled out of the scrollable area, displaying a third window comprising the additional materialization entity, at least in part, in the a materialization area of the third window, wherein the third window is separate from the first window and the second window (figure 5 ; bottom adjacent window).

As for Claims 11, Graham teaches the method and corresponding article and apparatus further comprising: in response to a user signal with respect to the materialization entity in the materialization area, scrolling the first subset of information such that the materialization entity is displayed in the scrollable area (figure 5).

As for Claims 12, Graham teaches the method and corresponding article and apparatus wherein the materialization entity is associated with a materialization entity designation of temporary, further comprising: in response to a user signal to not view the first subset of disassociating the materialization attribute from the materialization entity (figure 7).

As for Claims 13, Graham teaches the method and corresponding article and apparatus wherein the materialization entity is associated with a materialization entity designation of permanent, further comprising when the materialization entity designation is permanent, storing the materialization entity designation in persistent storage (col.6, lines 53-59).

As for Claims 40, Graham teaches the method of Claim 1 and corresponding article and apparatus of claims 14 and 27 wherein the materialization entity comprises the second subset of information, wherein said displaying of the materialization entity displays at least a portion of the second subset of information in the materialization area (col.8, lines 50-64).

As for Claims 41, Graham teaches the method of Claim 1 and corresponding article and apparatus of claims 14 and 27 further comprising: receiving a selection of the second subset of information on a graphical user interface; and in response to an activation of a create materialization entity control of the graphical user interface, designating the

second subset of information as the materialization entity (figure 5-7; col.7, lines 35-45, 54-63).

As for claim 46, Graham teaches the method 1 wherein the materialization entity is tagged information (col.6, lines 40-46).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8, 10 and 47-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham.

As for Claims 8, Graham teaches the method and corresponding article and apparatus further comprising: in response to the materialization entity being scrolled back into the scrollable area, deleting the materialization area containing the materialization entity (figure 6a-b; col.6, lines 53-59). However, Graham does not expressly disclose that the materialization entity is deleted automatically from the materialization area or more specifically; in response to the materialization entity being scrolled back into the scrollable area, deleting automatically the materialization entity from the materialization area, wherein the materialization entity is not displayed in the materialization area.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the removal of materialization entities automatically, this is because Graham suggest the user able to scroll in and out of documents with materialization entities and being able to remove them from user interaction of the system (col.8, lines 19-26) whenever during user interacting with the scrolling navigation graphical user interface element, such that the document can be scrolled in view and the user can at that time select to remove materialization entities, it would be obvious that the user would not need to view the materialization entities at the time of the document being scrolled into view in the view window, thus it would be obvious to automate this process which was manually created by the user for better navigation by the user during interaction with the graphical user interface in such that there is an automatic population of materialization entities to keep track of areas of interest when the documents are out of view and when they are in view, to remove them from the list

to create a less cluttered space and easier view to navigate to materialization entities which are not in current view.

As for Claims 10, Graham teaches the method and corresponding article and apparatus further comprising: in response to the materialization entity being scrolled back into the scrollable area, deleting the materialization entity from the materialization area (figure 7, col.8, lines 19-26). However, Graham does not expressly disclose that the materialization entity is deleted automatically from the materialization area or more specifically; in response to the materialization entity being scrolled back into the scrollable area, deleting automatically the materialization entity from the materialization area, wherein the materialization entity is not displayed in the materialization area.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the removal of materialization entities automatically, this is because Graham suggest the user able to scroll in and out of documents with materialization entities and being able to remove them from user interaction of the system (col.8, lines 19-26) whenever during user interacting with the scrolling navigation graphical user interface element, such that the document can be scrolled in view and the user can at that time select to remove materialization entities, it would be obvious that the user would not need to view the materialization entities at the time of the document being scrolled into view in the view window, thus it would be obvious to

automate this process which was manually created by the user for better navigation by the user during interaction with the graphical user interface in such that there is an automatic population of materialization entities to keep track of areas of interest when the documents are out of view and when they are in view, to remove them from the list to create a less cluttered space and easier view to navigate to materialization entities which are not in current view.

As for claim 47, Graham teaches a method of displaying information, comprising:

presenting a first subset of information in a scrollable area;

receiving a selection of a second subset of information of the first subset of information; in response to receiving a create materialization entity activation, designating the second subset of information of the first subset of information as a materialization entity; in response to the first subset of information in the scrollable area being scrolled and at least a portion of the materialization entity being scrolled out of the scrollable area, displaying the materialization entity in a materialization area, the materialization area being different from the scrollable area; and (note the analysis of claim 1 above).

However, Graham does not expressly disclose that the materialization entity is removed automatically from the materialization area or more specifically; in response to the materialization entity being scrolled back into the scrollable area, removing the

materialization entity from the materialization area, wherein the materialization entity is not displayed in the materialization area.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the removal of materialization entities automatically, this is because Graham suggest the user able to scroll in and out of documents with materialization entities and being able to remove them from user interaction of the system (col.8, lines 19-26) whenever during user interacting with the scrolling navigation graphical user interface element, such that the document can be scrolled in view and the user can at that time select to remove materialization entities, it would be obvious that the user would not need to view the materialization entities at the time of the document being scrolled into view in the view window, thus it would be obvious to automate this process which was manually created by the user for better navigation by the user during interaction with the graphical user interface in such that there is an automatic population of materialization entities to keep track of areas of interest when the documents are out of view and when they are in view, to remove them from the list to create a less cluttered space and easier view to navigate to materialization entities which are not in current view.

As for claim 48, Graham teaches the method of Claim 47 wherein the second subset of information is designated as a materialization entity using tags (col.6, lines 40-46).

As for claim 49, Graham teaches the method of Claim 1 wherein the materialization area is displayed in response to the at least a portion of the materialization entity being scrolled out of the scrollable area (col.7, lines 2-7).

As for claim 50, Graham teaches a computer-implemented method of displaying information, comprising: *displaying a first subset of information in a scrollable area, the first subset of information comprising a tagged information, the tagged information being a materialization entity, wherein the tagged information is not displayed in a materialization area; in response to the first subset of information in the scrollable area being scrolled and at least a portion of the tagged information being scrolled out of the scrollable area, displaying the tagged information, at least in part, in the materialization area; and* (note the analysis of claim 1 above).

However, Graham does not expressly disclose that the materialization entity is removed automatically from the materialization area or more specifically;

in response to the materialization entity being scrolled back into the scrollable area, removing the materialization entity from the materialization area, wherein the materialization entity is not displayed in the materialization area.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the removal of materialization entities automatically, this is because Graham suggest the user able to scroll in and out of documents with materialization entities and being able to remove them from user interaction of the system (col.8, lines 19-26) whenever during user interacting with the scrolling navigation

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graphical user interface element, such that the document can be scrolled in view and the user can at that time select to remove materialization entities, it would be obvious that the user would not need to view the materialization entities at the time of the document being scrolled into view in the view window, thus it would be obvious to automate this process which was manually created by the user for better navigation by the user during interaction with the graphical user interface in such that there is an automatic population of materialization entities to keep track of areas of interest when the documents are out of view and when they are in view, to remove them from the list to create a less cluttered space and easier view to navigate to materialization entities which are not in current view.

As for Claim 51, Graham teaches the method of Claim 50 wherein the tagged information comprises text (figure 5).

As for Claim 52, Graham teaches the method of Claim 50 wherein the tagged information comprises at least one object (figure 5).

As for Claim 53, Graham teaches the method of Claim 50 wherein the materialization entity is designated using XML tags (col.6, lines 40-46)

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As for Claim 54, Graham teaches the method of Claim 50 wherein the materialization entity is designated using a start materialization entity tag and an end materialization entity tag (figure 1A, the beginning of the graph marks the beginning of the first annotated entities and the ending part of the graph marks the ending of the last annotated entities).

As for Claim 55, Graham teaches the method of Claim 50 wherein the materialization area is different from the scrollable area (figure 7)

As for Claim 56, Graham teaches the method of Claim 50 wherein the materialization area is displayed in response to the at least a portion of the tagged information being scrolled out of the scrollable area (col.7, lines 2-7)

(Note:) It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Response to Arguments

Applicant's arguments filed 3/26/2008 have been fully considered but they are not persuasive.

After careful review of the amended claims (given the broadest interpretation) and the remarks provided by the Applicant along with the cited reference(s) the Examiner does not agree with the Applicant for at least the reasons provided below:

A1. Applicant argues that the sensitivity control of the Graham patent does not cause the document to be scrolled.

R1. Examiner does not agree, as the user navigates within the interface, such as scrolling a document, the sensitivity control dynamically finds materialization entities as suggested in col.6, lines 32-64.

A2. Applicant argues that concept indicator is not a subset of information.

R2. Examiner does not agree, the concept indicators are related to the document currently being read by the user, thus "subset information" (col.7, lines 1-15). As read by the claim language the materialization entity is related to the information being displayed to the user of the system which is the same functionality as the concept indicator. Examiner suggest that a distinction can be made between what the Applicant intends and what is currently trying to be claimed.

A3. Applicant argues that Graham does not teach in response to the first subset of information in the scrollable area being scrolled and at least a portion of the materialization entity being scrolled out of the scrollable area, displaying the materialization entity at least in part in the materialization area.

R3. Examiner does not agree, the claim is not distinctly claiming to a time dependent step that includes a specific amount of information required to be displayed at a location during a specific time, therefore when Graham teaches that entities are identified on the document and displayed in the materialization area the user is able to scroll the document out of view thus still having some entities in view and out of view. Examiner suggests better clarification as argued by the Applicant in the remarks to convey in the claim language the specific functionality as Applicant intends the claim to represent.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Augustine whose telephone number is 571-270-1056. The examiner can normally be reached on Monday - Friday: 7:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Augustine/
Examiner
Art Unit 2179
June 20, 2008

/Ba Huynh/
Primary Examiner, Art Unit 2179